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REMARKS/ARGUMENTS

Introduction

In the Office Action dated July 1, 2004, the Examiner rejected all claims (1 – 20) under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,778,173 ("*Apte*") and U.S. Patent No. 5,319,700 ("*Mano*"). The Examiner characterized *Apte* as disclosing a system allowing communication of transaction information via two separate communication paths, namely using the Internet and a telephone line, but failing to disclose monitoring the status of a terminal adapter. Further, *Mano* was characterized as disclosing a terminal adapter pooling system that monitors status information. It was alleged that it was obvious to one of ordinary skill in the art to modify *Apte* with the terminal monitoring system as taught by *Mano*, thus disclosing all the limitations recited in the claims.

Applicant submits that the combination of the two references does not render obvious all the limitations of the claims. Because the combination of the references does not lead to a likelihood of success, and further, that several limitations recited in the independent claims 1 and 11 are not disclosed either individually or separately by either reference, the combination of the references is improper and further does not disclose all of the claimed limitations. Therefore, a *prima facie* case of obviousness has not been established. Applicant respectfully submits the claims are patentable over the cited references and requests that the claims be placed in a condition of allowance.

Discussion Of Prior Art

In order to better distinguish the present invention from the cited references, it is appropriate to briefly review the disclosure of *Apte* and *Mano* at a high level prior to discussing issues associated with the combination of the references.

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The *Apte* Reference

Apte does disclose a system that communicates separately both over the Internet and a telephone line. However, the manner and reason disclosed by *Apte* for switching from using the Internet to using a modem for point-to-point communications is different from the present invention. *Apte* discloses a person using the Internet to identify products to be purchased and automatically terminating the Internet communication prior to purchasing the product and then using a modem to establish a point-to-point telephone connection to complete the purchase transaction in a secure manner.

In *Apte*, the user browses the World Wide Web (WWW) to identify products at a merchant's web server to be purchased. Once the user has selected a product to purchase, the user sends a purchase order number (or other transaction identifier number) to the web server. The web server then relays this purchase order number to a transaction server. Then, the user's computer disconnects from the Internet and "the user subsequently pays for the purchase by initiating communication between the computer and the transaction server over another communication system [the telephone network] that is isolated from the WWW... The user provides the purchase order number to the transaction server and proceeds to complete the purchase by providing a credit number. Since the transaction server is isolated from the open WWW the inherent risks of communicating sensitive information is avoided." (Col. 2, lines 54-63, see also Figure 1.)

As described by *Apte* (see e.g., col. 2 lines 1-65), that system "allows an individual to browse the open World Wide Web (WWW) and in a seamless manner to perform secure transactions over a secure electronic communication medium [i.e., the telephone network] that is isolated from the WWW." (col. 2, lines 15-18.) The reason for doing so is that it allows users to send credit card information over a secure link and avoid "the inherent risks of communicating sensitive information [over the open WWW.]" (col. 2, lines 63-64).

Thus, the user's computer monitors and detects when the user initiates a purchase transaction and purposefully disconnects from the Internet and dials a telephone number in order

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to transmit the sensitive information (credit card information) over a point-to-point telephone line. (As a peripheral comment, it is common usage now to use the Internet and actually transact a purchase over the Internet using well known security and encryption mechanisms to minimize any inherent risk of sending sensitive information communicated over the Internet.)

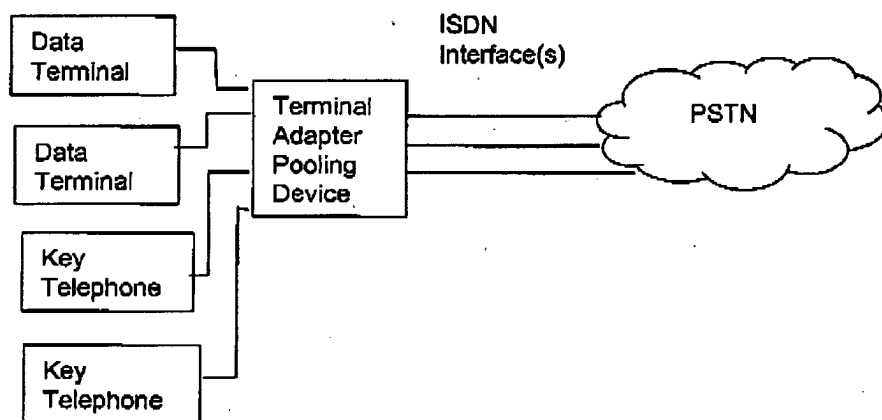
In contrast to *Apte*, one aspect of the present invention is a flexible terminal adaptor using a communication path over the Internet to normally transfer purchase transaction data, such as credit card information. The system of the present invention uses encryption technology to minimize any inherent risks of communicating sensitive information. In the present system, if there is a failure of the Internet, the failure of the communication path is detected and the versatile terminal adapter allows the transactions to be completed using a telephone line as a backup communication means.

As is evident, the basis of using the Internet versus dial-up communication in *Apte* is fundamentally different from the present invention. *Apte* uses different communication paths to exclusively send different types of information (e.g., product selection versus purchase transaction), whereas the present invention involves using different communication paths to send the same type of information (typically, purchase transaction information), but using the telephone communication only as a back-up communication path. If the mode of operation of *Apte* were applied to the present invention, then every transaction would normally occur using the telephone line and the Internet communication path would never be used!

***Mano* Reference**

The *Mano* reference pertains to pooling (i.e., sharing) a terminal adapter among various data terminals accessing the ISDN (see, e.g., col. 1 generally of *Mano*). Because the focus of *Mano* is on the details of the terminal adaptor, it is useful to review how the terminal adaptor relates to other components. A simplified architecture of the main components based on Figure 1 and the text in column 1 of *Mano* is shown below:

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Mano discloses the Terminal Adapter providing connectivity to various data terminals and/or key telephones with the ISDN service provider (the PSTN – public switched telephone network). The *Mano* reference discloses procedures for interworking messages from the data terminals with ISDN call control procedures. Thus, the terminal adapter allows calls to be established by data terminals using various message protocols and the ISDN, which has its own message protocols.

Because *Mano* is at most only concerned with the interface to the communication network, *Mano* does not disclose any of the systems or processes within the communication network (e.g., the public switched telephone network or “PSTN”). Thus, *Mano* does not disclose a Network Operations Center in the PSTN, nor does it disclose sending or monitoring status signals from the Terminal Adapter to a Network Operations Center in the PSTN. In fact, *Mano*

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does not even disclose the PSTN itself in any of the figures, just interfaces connecting to the PSTN.

Basic Requirements of a Prima Facie Case of Obviousness

According to the MPEP §2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In this case, none of the three criteria are not met. Namely:

- a) The two references are directed to different technologies and solve different problems. There is no motivation, or suggestion, to combine the references.
- b) There is no reasonable expectation of success by combining the two references, because the combination produces a system operating in a different manner and solving a different problem. Therefore, the combination is inappropriate. See MPEP §2143.02.
- c) The combination of the references does not teach or suggest all claim limitations. See MPEP §2143.03.

No Motivation or Suggestion to Combine the References

Apte deals with solving the problem of performing secure transactions over the World Wide Web (see *Apte*, Field of Invention, col. 1, lines 5-10). *Mano* is directed to a terminal adapter pooling system for ISDN that allows a plurality of data terminals to use an ISDN interface. Applicant respectfully submits that these solve different and non-overlapping problems. *Apte* is not concerned with ISDN interfaces and does not even disclose ISDN

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interfaces at all. Instead, *Apte* interfaces with a "telephone link (i.e., a circuit switches POTS connection)." (*Apte*, col. 2 lines 22-23.) ISDN and POTS are different communication technologies as is well known in the area of telecommunications. *Mano* is not concerned, nor deals with, secure transactions, let alone transactions over the World Wide Web. *Mano* addresses interworking non-ISDN data terminals with ISDN interfaces by sharing resources. Thus, *Apte* and *Mano* solve different problems and use different technologies. As expected, and consistent with this assertion, Applicant notes that the U.S. and international classification of the patents are also different.

No Reasonable Expectation of Success

A *prima facie* case of requires that the combination of references provides a reasonable expectation of success. This does not occur when combining *Apte* and *Mano*. *Apte* discloses using an Internet connection for viewing product selection information, terminating the Internet session, and then using a separate telephone connection for completing the purchase transaction in a secure manner. *Apte* specifically teaches away from using the Internet to transfer sensitive information. Applying *Apte* to the present invention for purchase transactions would result in only using the modem based, point-to-point telephone connection for completing a transaction.

Further, *Mano* discloses a terminal adaptor that monitors signals from various data terminals and maps the messages to ISDN messages (see, e.g., Figure 18 of *Mano*). These messages allow a call to be established using the ISDN network. However, *Mano* does not disclose a Network Operations Center in the network, nor does it disclose the Network Operations Center recording any information in a table, such as a status update message.

Thus, the combination of *Apte* and *Mano* fails to produce a system operating as disclosed in the present specification. Thus, the combination cannot be expected to provide a reasonable expectation of success.

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The Combination Of References Does Not Teach Or Suggest All Claim Limitations

Claims 1-20 include two independent claims. Claim 1 is a method-based claim associated with dependent claims 2-11. Independent claim 12 is a system-based claim associated with dependent claims 13-20. By demonstrating that the combination of references does not teach or suggest the limitations of an independent claim, the independent claim and all depending claims are patentable over the combination of references. Thus, the following discussion focuses on distinguishing claim 1 and claim 12 from the cited references based on the limitations underlined, although the dependent claim limitations can also be distinguished.

Independent Claim 1

For ease of reference, independent claim 1 is reproduced below:

1. A method for maintaining a status indication in a network operations center for a terminal adapter connected to a network node, comprising the steps of:
receiving a first status update message from the terminal adapter by the network node indicating a first parameter file version number stored in the memory of the terminal adapter, the first status update message further including a terminal adapter identification number and a first primary communication path status;
relaying the first status update message from the network node to the network operations center;
receiving the first status update message at the network operations center and examining the terminal identification number and the parameter file version number; and
recording a status indication and recording time in a status indication table at the network operations center, wherein the status indication table associates the status indication and recording time with the terminal adapter identification number.

While there are various limitations that are not taught or suggested from the combination of the cited references, only one limitation is discussed herein. If the prior art fails to anticipate even a single limitation, then the prior art does not anticipate the claim. One limitation that is not anticipated is the "recording a status indication and recording time" at the network operations

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center. As indicated by the underlined text, the status message includes at least 1) a first parameter file versions number, 2) a terminal adapter identification number, and 3) a first primary communication path status. These are recorded in a table in the network operations center.

The *Apte* and *Mano* references fail to even disclose a "network operations center," much less recording any information therein, and much less disclosing this particular type of information being conveyed and recorded. Because at least these limitations are not taught or suggested by the combination of the references, independent claim 1 is patentable over the combination of *Apte* and *Mano*.

Because dependent claims 2-10 incorporate the limitations of claim 1, claims 2-10 are also patentable over the combination of *Apte* and *Mano*.

Independent Claim 12

For ease of reference, independent claim 12 is reproduced below:

12. A system for maintaining a status in a network operations center of a terminal adapter connected to a transaction network comprising:
a network operatively connected to the terminal adapter to receive a first status indication message from the terminal adapter, the first status indication message including a terminal identification number, a first parameter file version number, and a first communication path status indicator; and
a network operations center operatively connected to the network adapter to receive the first status indication message from the network, the network operations center comprising a processor and memory, the processor determining a time associated with the receipt of the first status indication message in a status table and starting a timer, and the memory storing the status table associated with the terminal identification number.

Similar to independent claim 1, independent claim 12 recites a "status indication message" that includes 1) a terminal identification number, 2) a parameter file version number,

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and 3) a communication path status indicator, which is received by a network operation center connected to the network.

As previously indicated, neither *Apte* nor *Mano* disclose a network operations center, let alone a network operations center receiving a status indication message, let alone the status indication message including the above identified information.

Thus, the combination of references of *Apte* and *Mano* does not disclose at least the above limitations. For at least this reason, the combination does not render independent claim 12 obvious. Further, because dependent claims 13-20 incorporate the limitations of claim 12 by virtue of depending from claim 12, neither are claims 13-20 rendered obvious by the combination of *Apte* and *Mano*.

CONCLUSION

Applicant submits that the combination of *Apte* and *Mano* is inappropriate to establish a *prima facie* case of obviousness, since none of the require three criteria are met. First, the references are directed to different technologies and solving different problems, and there is no motivation shown for combining the references. Second, a reasonable expectation of success is not possible with the combination of references. The resulting system would be inconsistent with the system as disclosed in the present specification, nor with the operation as recited in the claims.

Further, even if the references were combined, not all of the claimed limitations as recited in the independent claims would be taught or suggested by the combination. Thus, for at least these reasons, applicant submits that the claims are in a condition for allowance and respectfully requests that all claims be allowed.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of

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this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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Date